

### **EXAMINER INTERVIEW**

Applicants would like to thank Examiner Werner for the courtesies extended during the recent telephone conference. During the telephone conference, proposed amendments were discussed and differences noted by the Examiner. No agreement as to the patentability of the claims was reached.

### **REMARKS**

Claims 1-2, 4-37 and 44-47 are now pending in the application. Claims 1-2, 4-37 and 44-47 stand rejected. Claims 1, 9, 22, 27, 33 and 34 have been amended. Support for the amendments can be found throughout the application, drawings and claims as originally filed and, as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **ALLOWABLE SUBJECT MATTER**

Applicants acknowledge that the previously indicated allowability of Claim 33 is withdrawn in view of the newly discovered reference to Noiles (U.S. Pat. No. 4,978,356), detailed below.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-2, 4-19, 21-37 and 44-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noiles (U.S. Pat. No. 4,978,356) (hereinafter "Noiles '356") in

view of Sullivan et al. (U.S. Publication No. 2003/0125810). This rejection is respectfully traversed.

The Examiner's attention is directed to independent Claim 1 which has been amended to contain the limitations "a locking mechanism configured to fixably couple a second prosthetic implant having a second spherical concave bearing surface so as to prevent relative movement therebetween." These limitations can be contrasted with the support surfaces of the Noiles reference (US Patent 4,978,356), which rotatably support a bearing insert and are not structurally configured to fixably couple a second prosthetic implant to the spherical concave bearing surface.

With respect to the rejection of Claims 1-2, 4-19, 21-37 and 44-47 under 35 U.S.C. § 103(a), the Office cites Figure 6 of the Noiles reference as teaching a locking mechanism (28). While Applicants acknowledge that element (28) of Noiles may inhibit the removal of the liner bearing element (12), it does not teach a locking element coupled to the bearing surface configured to prevent relative movement between the integral generally spherical polished concave bearing surface and the second prosthetic as is claimed.

Applicants assert Noiles either fails to teach or teaches away from the second prosthetic coupled to the polished low friction surface in Sullivan in the manner claimed. In this regard, Noiles teaches a bearing liner specifically designed to articulate within the cup structure under various constraint levels. The Supreme Court recently addressed teaching away in the KSR opinion:

The [Adams] Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*,

at 51-52, 86 S.Ct. 708. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed.

*KSR International Co. v. Teleflex Inc.*, 127 S.Ct. at 1740, 82 USPQ2d at 1395 (emphasis added).

Applicants note that the use of a polished interior surface allows the physician to interoperatively determine whether to use a metal on metal bearing system, a lined, or a constrained bearing system. Additionally, the system allows for revision of the joint without replacing the acetabular cup. Applicants respectfully assert that these are useful functions and add to the nature and quality of the prosthetic system.

Applicants further respectfully assert that the proposed modification of the Noiles reference cannot render the prior art unsatisfactory for its intended purpose. As such, one skilled in the art would not combine the references. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). See also *McGinley v. Franklin Sports Inc.*, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). In this regard, modification of the locking mechanism of Noiles to prevent rotation of the bearing and to include the surface of Sullivan would render Noiles unsatisfactory as a bearing system disclosed inasmuch as the configuration of Noiles allows rotation of the polymer liner with respect to the cup. Removal of the rotation feature obviates the need for a polished articulating surface in the support cup as is claimed.

Applicants submit the proposed modification of the Noiles reference changes the principle of operation of the Noiles reference inasmuch as the interior surface of Noiles is configured to allow rotation of the member in contact with the interior surface (see the discussion above related to locking mechanism). It is a long held principle that if the

proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious, *In re Ratti*, 270 F.2d 810 (CCPA 1959). (See MPEP §2143.01).

Claims 22, 27 and 34 have been similarly amended to contain the limitation that the locking mechanism is configured to prevent relative movement of the second prosthetic member with respect to the first prosthetic. In this regard, Claim 22 has been amended to include the limitation that the locking mechanism prevents “relative movement of the second prosthetic device with respect to the integral polished spherical bearing surface.” Further, Claim 27 has been amended to include the limitation that the locking mechanism is configured “to prevent relative movement of the second prosthetic with respect to the integral polished internal bearing surface.” Claim 34 has been amended to include the limitation the second prosthetic is coupled to said locking mechanism “so as to prevent relative movement of the second prosthetic member with respect to the first prosthetic.” Applicants respectfully submit the cited references do not teach these limitations in combination as claimed. For this reason and the reasons stated above, Applicants assert the rejections have been obviated.

With respect to the cited Sullivan reference, Applicants note that the hardness and smoothness is directed to a convex humeral articulating portion of a prosthetic joint and not the concave surface of Claim 1 and its dependents. Further, the figures of the Sullivan reference appear to disclose at least a two-piece glenoid component having a concave bearing surface. Figures 1 and 2 show a concave bearing surface formed of more than one material (see element 8). There is no teaching in the Sullivan reference

of a concave prosthetic that can act both as a support of a second prosthetic and an articulating bearing surface. One simply would not be motivated to combine the references to provide a polished concave bearing surface with a locking mechanism configured to fixably couple a second implant with a spherical bearing surface. This combination is simply missing from the references.

Claims 44-47 were newly presented in the last Amendment submitted. Applicants note that while the Office recites in the Office Action that these claims are rejected, no basis for the rejections was provided. Applicants respectfully submit that each of the limitations of these claims is not shown in the references cited. As such the rejections are improper.

Claims 44 and 47 depend on independent Claim 1, Claim 45 depends on independent Claim 22, and Claim 46 depends upon independent Claim 34. Applicants respectfully submit these claims can be distinguished from the cited references for at least the reasons stated above. In this regard, Applicants submit that the cited references cannot be combined as the proposed modification of the references make them unsatisfactory for their intended purpose.

With respect to the rejection of Claim 33, the Office asserts the Noiles reference teaches the liner can be replaced. While this may be reasonable description of the teachings of Noiles, Applicants submit that the combinations of references do not teach the limitations as claimed. In this regard, the Examiner's attention is directed to Claim 33 which contains the limitation "a locking mechanism which is configured to fixably accept a second prosthetic having a second bearing surface which substantially surrounds a head portion of a femoral component, to a prepared joint." As described

above, Applicants submit that Noiles discloses an articulating bearing member and does not teach the polished bearing surface as is claimed.

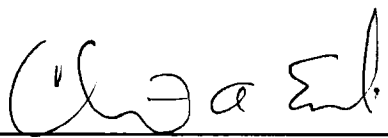
Claim 20 stands rejected as being unpatentable over Noiles '356 in view of Sullivan et al., as applied to Claim 9 above, and further in view of Noiles et al. (U.S. Pat. No. 5,413,603) (hereinafter "Noiles '603"). For at least the reasons stated above, Applicants assert the references do not teach each of the limitations and, as such, the rejections have been obviated.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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